



Paper No. 11

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OFFICE OF PETITIONS

In re Application of
Kenneth W. Henry et al.
Application No. 10/053,183
Filed: November 9, 2001
Attorney Docket No. 170-00-004

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the request for reconsideration filed on October 8, 2002, with a request for a two month extension of time.¹

The request for reconsideration is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The oath or declaration in the above identified application has been signed by joint inventors Henry and Inskeep. In the petition under 37 CFR 1.47 (a) filed April 19, 2002, applicants indicated that joint inventor Rhoden is deceased and that at present, no administrator or executor had been appointed to the estate of James A. Rhoden.

The supplemental information provided with the request for reconsideration consisted of an oath or declaration signed by Robert Desmond as the attorney-in-fact and on behalf of James A. Rhoden. According to the applicant, the authority for Mr. Desmond's signature on behalf of Mr. Rhoden is that Mr. Rhoden, on June 5, 1967, "irrevocably appointed Honeywell International Inc. (Previously known as "Airsearch Manufacturing Company of Arizona) as his attorney-in-fact pursuant to an invention and secrecy agreement." Mr. Desmond's title is Chief, Intellectual Property Counsel - Engines, Systems & Services, Honeywell International Inc.

Pursuant to 37 CFR § 1.64 the following applies when a person making oath or declaration is other than the inventor:

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors **except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.**

¹A petition under 37 CFR 1.47(a) was filed April 19, 2002 and dismissed by the USPTO in a decision dated July 8, 2002.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

The agreement between Mr. Rhoden and Honeywell (Airsearch) does not indicate that the agreement between the parties survives the death of the grantor. It should be noted that even an irrevocable power of attorney can be revoked by the death of the grantor. Therein, the petition still lacks items (1), (2) and (4).

We will reiterate the points set out in our July 8, 2002 decision.

Petitioners are advised that 37 CFR 1.47 is not considered an alternative to 37 CFR 1.42 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor.² 37 CFR 1.42 states that when the inventor is dead, the legal representative may make the necessary oath or declaration. 37 CFR 1.47 will apply when a known legal representative cannot be found or refuses to sign the declaration. In such cases, the last known address of the legal representative must be established before the grant of a patent.³ When petitioners initially filed this declaration and petition under 37 CFR 1.47(a), perhaps no legal representative for the deceased inventor, Rhoden, had been named. Presumably in the subsequent time period a legal representative has been named.

To establish 37 CFR 1.47 status, petitioner must submit a 37 CFR 1.47 petition on behalf of the legal representative of the deceased inventor.

In regards to item (1), the mere statement that the deceased joint inventor's widow had not been appointed the administrator/executor and that she was unaware of who or how to reach such administrator/executor, is insufficient to show that a diligent effort was made to locate Rhoden's legal representative. Where inability to find or locate a named inventor(s), or legal representative thereof, is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor or legal representative. The statement(s) of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay, will not normally be accepted. Petitioners should demonstrate that a thorough inspection of sources including, but not limited to, personnel or payroll records and probate filings. Petitioners should use diligent efforts to determine the current or last known address of the nearest living relative of the deceased inventor. Copies of the results of the search must be referred to in any renewed petition.⁴

²In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955).

³See 37 CFR 1.42.

⁴See MPEP 409.03(d).

Additionally, Rhoden's legal representative or heirs will have to be proffered the complete application papers (specification, including claims, drawings, if any, and the declaration) for signature.⁵ In the event that the legal representative or heirs refuse to sign the declaration, petitioners may provide proof that a copy of the application was sent or given to the legal representative for review by providing, with a renewed petition, a copy of the cover letter transmitting the application papers to the legal representative or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

In the event that Rhoden's legal representative refuses in writing to sign the declaration, petitioners should provide a copy of the written refusal with any renewed petition. If the refusal is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the oath or declaration must identify the name, residence, mailing address, and citizenship of the legal representative of the deceased inventor, and state that the legal representative is signing on behalf of the deceased joint inventor. A new oath or declaration in compliance with 37 CFR 1.63 and 1.64, containing the information described in this paragraph, is required.

In reference to item (4), above, the petition must include the last known address of the legal representative of the deceased joint inventor.

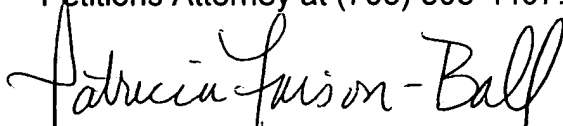
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703) 305-4497.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

⁵See also MPEP 409.01(a),(b); 409.03(c).